

Art Unit: 3600



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/877,926

Filing Date: June 08, 2001

Appellant(s): ROBB, PAUL H.

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S. Jafar Ali  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the Amended Appeal Brief filed 04/01/2008 appealing from the Office action mailed 01/30/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Copending U.S. application number 09/732,008 is a related appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**GROUND OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 09/877,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because: A "forum" encompasses a "collaboration tool", "defining a scope of authorization" encompasses "encryption", and a "library of resources" encompasses a "database".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the appellant disagrees with the provisional double-patenting rejections set forth by the Examiner, the Appellant did not address these provisional rejections in the Appeal Brief. Rather, the appellant states the appellant will file a terminal disclaimer upon the indication of allowable subject matter.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

5,940,843	Zucknovich et al.	08-1999
6,430,,542	Moran	08-2002
5,787,175	Carter	07-1998
6,243,722	Day et al.	06-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims there is recited terms that are indefinite because there is no clear definition of the meets and bounds of the term. The terms include:

"collaborate" "enabling" "to interact" "forum".

In dependant claims there is recited. "events" and "actions" which are also terms that are indefinite because there is no clear definition of the meets and bounds of the term.

The terms "client" and "participants" are confusing since the relationship between the two is not recited (i.e.: are the participants clients of the client?).

The term "library of resources" is vague and indefinite since the entire Internet could be defined as such.

The recitations of claims 4 and 18 are confusing as a whole because the interrelationships claimed are not clear.

All claims will be examined as best understood.

Claims 28-54 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-19, 22-32, 34-46, 49-54, 57-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. (US 5940843).

Zucknovich et al discloses a method for providing a tool with which a client and

one or more participants may interact. A client defines a collaboration team comprising one or more participants (col 1, Lines 50-56). The client submits client data to the tool in a common format (col 5, lines 60-67). The participants comprise one or more entities authorized by the client to participate in the tool, wherein the client also defines the scope of authorization for each participant (col 6, lines 25-30). The client interacts with one or more participants through the tool, wherein interaction among participants comprises exchange of client data (col 87, Lines 14-50). The participants may be financial advisors (col 5, lines 55-56).

The client data comprises financial documents as a work product (col 2, Lines 41-50). There is enabled the client to access a client history database wherein the client history database maintains information related to previous actions (col 83, Lines 26-45). A library of resources is disclosed since there is taught access to the Internet. Zucknovich et al does not use the word "forum" to describe what their tool provides.

It would have been obvious to one with ordinary skill in the art to include a common "forum" as describing the tool to Zucknovich et al because Zucknovich et al teach that research providers require interaction with those who desire their work product (col 1, Lines 39-44).

Claims 6, 20-21, 33, 47-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich as applied to claims above, and further in view of Moran (US-6,430,542 B1).

Zucknovich et al does not disclose a calendar function or planning means for

enabling participant to formulate a financial plan. Moran discloses a calendar function (fig 37) and a planning means for enabling participant to formulate a financial plan (col 1, lines 21-30).

It would have been obvious to one with ordinary skill in the art to include a calendar function to Zucknovich et al because Moran teaches that planning requires knowing timelines for answering planning questions (col 32, Lines 1-30).

It would have been obvious to one with ordinary skill in the art to include planning means for enabling participant to formulate a financial plan to Zucknovich et al because Moran teaches that financial advisors provide financial planning (col 1, Lines 25-26) and Zucknovich et al teaches advisors.

Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. as applied to claims above, and further in view of Carter (US 5787175).

Zucknovich et al does not disclose use of "encryption".

Carter discloses encryption of documents (fig 11).

It would have been obvious to one with ordinary skill in the art to include encryption to Zucknovich et al because Carter teaches encryption advantages to control access of documents (col 4, lines 1-18).

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. as applied to claims above, and further in view of Day et al. (US6243722).

Zucknovich et al does not disclose enabling the client to view participant input wherein participant input comprises one or more of edits, analysis and comments related to client data.

Day et al discloses disclose enabling the client to view participant input wherein

participant input comprises one or more or edits, analysis and comments related to client data ( col 3, Lines 45-67., col 4, Lines 1-25).

It would have been obvious to one with ordinary skill in the art to include participant input wherein participant input comprises one or more or edits, analysis and comments related to client data because Day et al teaches collaborative efforts require edits, analysis and comments (col 3, lines 45-64, col 4, lines 6-25), and Zucknovich et al teaches correction for inaccuracies of client data (col 1, lines 62-67., col 2, lines 1-25).

#### **(10) Response to Argument**

With regards to the appellants arguments concerning the 35 USC 112 second paragraph rejections, appellant states he respectfully disagrees with the rejection and states “the meanings of the terms [that are] indefinite are fully ascertainable through a reading of the claims in light of the specification **and/or** based on the ordinary English language meanings of these terms”. Again, Examiner disagrees and continues that the terms are yet to be defined by appellant’s arguments as appellant has used “and/or” when defining the terms. With regards to appellant’s argument that the dependent claims have a “blanket rejection” (page 20) is improper. The dependent claims encompass all the limitations and language of the independent claim from which it depends, as such; any issues directed to being indefinite also apply to any claims depending therefrom. Additionally, a “system” is not a statutory class of invention. In response to appellant’s argument against the 35 USC 112 second paragraph rejection, regarding “collaborate”, “enabling”, “to interact, “events”, and “actions” these terms have relative meaning. What may be considered such to one may not be considered such to another.



There are several 'participants' making the claims vague and overly broad in that it is unclear how the client differs and relates to each participant. In returning to the specification to clarify, the issue is made even more confusing as it appears that the terms 'client' and 'participant' are interchangeable. Additionally, appellant has not invoked 112 6<sup>th</sup> paragraph to assist in defining the terms and the metes and bounds of the invention claimed. Specifically as to appellant's argument on page 10 lines 14-18, appellant argues that it is "clear from the plain language of the claim" while the claim is unclear in that lines 2-3 of claim 1 refer to a financial services client and one or more financial services provider participants " but lines 4-6 refer to "enabling authorization of one or more participants to access client data" and " enabling a client or participant to submit client data. It is unclear if these participants and clients are financial clients and participants or they are additional to the financial clients and participants referred to in lines 2-3 of the claim. Examiner is using claim 1 as an example while the issue also exists in the remaining claims as well.

In response to that appellant's argument against the 112 2<sup>nd</sup> paragraph rejection to claims 20-38 as directed to a 'system', appellant has not identified which statutory class of invention the instant system claims would be directed merely arguing that a system claim is 'legal'. Regarding a system claim, since the term 'system' may encompass more than one statutory class, there is a requirement for an indication on the record as to what statutory class of invention the "system" claims belong to (see MPEP 2106.IV.B). The statutory provision for this requirement may be found in 35 U.S.C 101 that recites the statutory classes of invention.

Regarding the 35 U.S.C 103 rejection of record, the "interaction among the participants" and "an exchange of client data among the participants" is encompassed by what is disclosed by

Zucknovich. Zucknovich discloses data exchange via the Internet or other network device to participants (researchers) and interaction in the form of discussing the research reports. The terms “interact” and “exchange” are given the broadest possible meaning.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With regards appellants arguments against the 35 USC 103 rejections, since appellant has not argued the 35 USC 103 (a) rejection of claims 6, 20-21, 33, 47-48 as being unpatentable over Zucknovich further in view of Moran (US-6, 430,542 B1), Examiner will understand this as admitted prior art.

In response to appellant's argument that neither Zucknovich et al. nor Day et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Zucknovich et al. is both in the field of appellant's endeavor and is reasonably pertinent to the particular problem with which the appellant is concerned. Zucknovich et al. is concerned with distributing information to investors from a client. Day et al. is concerned with network based document (information) review tools via a computer network. Submitting information is analogous to submitting client data. Both involve an exchange of data.

In response to appellant's argument that Zucknovich et al. is nonanalogous art, it is repeated that it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Zucknovich et al is in the field of appellant's endeavor. Specifically, the system in Zucknovich et al. is capable of performing the function of the instant application regardless of whether it is a financial service provider or other type of service provider is irrelevant.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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